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In re Application of:

Vallittu, Pekka et al
Serial No.: 10/557,822
Filed: Nov. 23, 2005
Docket: TUR-173
Title: MATRIX BAND

: DECISION ON PETITION
: TO WITHDRAW FINALITY
: OF THE FINAL OFFICE
: ACTION

This is a decision on the petition filed on Mar. 28, 2008 to withdraw the finality of the Office action of Nov. 28, 2007. The petition is considered filed under 37 CFR §§ 1.144 and 1.181 and no fee is charged.

The petition is dismissed as untimely.

The record shows:

The examiner issued a non-final Office action on Jun. 12, 2007 rejecting original claims 1-15 in the case. In response to the office action, on Sep. 11, 2007 the applicant filed an amendment canceling claims 10-15 and added new method claims 16-19. On Nov. 28, 2007, the examiner issued a final Office action. In the final Office action, the examiner found the newly added claims 16-19 are directed to an independent or distinct invention and held the previously rejected claims 1-9 as a constructively elected invention. The non-elected method claims 16-19 stand withdrawn from consideration. On Mar 28, 2008, the current petition to withdraw the finality of the Office action of Nov. 28, 2007 was filed.

The petitioner's request to withdraw the finality of the Office action mailed on Nov. 28, 2007 was based on the fact that making the Office action final is premature because it contains a new restriction requirement. Petitioner also opines that there is no clear issue that has been developed with respect to the newly added method claims 16-19.

Discussion and Analysis

In the petition, petitioner argues that the newly added method claims 16-19 correspond to original and now cancelled "use" claims 12-15, which were searched and examined in the first Office action. Accordingly, method claims 16-19 are properly part of the originally presented invention, and should not have been withdrawn from examination based on a constructive election. These newly added method claims 16-19 should have been either examined or properly restricted before the Official action was made final.

A review of the record shows that the instant petition was filed more than three months after the mailing date of the final Office action of Nov. 28, 2007. Pursuant to 37 CFR § 1.181(f)¹, the petition is not timely filed since the petition was not filed within two months of the action to which there is a complaint. As the petition was not timely filed, the relief requested will not be granted. Petitioner is entitled to request reconsideration of this decision provided that the request for reconsideration is filed within two months of the date of this decision.

However, as a matter of courtesy, a review of the restriction requirement also has been made. The newly added method claims 16-19 are in fact not included in the original filed national stage application under 37 U.S.C. § 371 prior to the first Office action. The newly added method claims 16-19 are not coextensive to the cancelled original "use" claims 10-15. Therefore, the PCT rules of lack of unity do not apply to the newly added method claims 16-19. It is also noted that petitioner did not present any arguments to rebut why the newly added method claims 16-19 cannot be practiced by another materially different apparatus or the apparatus as claimed in originally presented claims 1-9 cannot be used to practice another and materially different process. (MPEP § 806.05(e)). Moreover, the rejections under 35 U.S.C. §§ 102 and 103 evidence that a special technical feature is lacking from any of the claims that may be defined as independent thereby establishing in the International application that there is no unity in the original claims to prohibit either a holding of lack of unity or a restriction requirement. See MPEP § 1850. Therefore, the restriction requirement based on constructive election is found proper in accordance with MPEP § 818.01, 821.03 and 37 CFR § 1.145.

Conclusion

In view of the record, petitioner's request to withdraw the finality of the Office action dated Nov. 28, 2007 is dismissed as untimely.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision, 37 CFR 1.181(f). No extension of time under 37 CFR 1.136(a) is permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.181". The application is being forwarded to the Supervisory Patent Examiner of Art Unit 3732 waiting for applicant's response to the final Office action of Nov. 28, 2007. Any inquiry regarding this decision should be directed to Henry Yuen, Special Programs Examiner, at (571) 272-4856.

Petition Dismissed as Untimely.



Frederick R. Schmidt, Director
Technology Center 3700

¹ 37 CFR 1.181(f): The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.